



07-18-06

AF
JFW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

IN RE: KUMAR, Vijay et al.)
) APPEAL NO. _____
SERIAL NO: 10/007,866)
)
FOR: BIODEGRADABLE OXIDIZED) REPLY BRIEF
CELLULOSE ESTERS)
)
FILED: December 6, 2001)
)
GROUP ART UNIT: 1623)


To the Commissioner of Patents and Trademarks
P. O. Box 1450
Alexandria, VA 22313-1450

Dear Sirs:

Appellants respectfully request that the following Reply Brief be entered into the record. It addresses only new arguments set forth in the Examiner's Answer made in response to Appellant's Argument (Examiner's Answer p. 4, Section 10 "Response to Argument").

CERTIFICATE OF MAILING BY EXPRESS MAIL

I hereby certify that this document and the documents referred to as enclosed therein are being deposited with the U. S. Postal Service in an envelope as "Express Mail Post Office to Addressee" addressed to: Commissioner of Patents, P. O. Box 1450, Alexandria, VA 22313-1450, prior to 5:00 p.m. on 17th day of July, 2006.



Patricia E. Wilson
Express Mail Label #EV 491752048 US

I. Introduction

The arguments made in the Examiner's answer are not relevant to the well established factors relating to the new matter determination imposed by the Federal Circuit. The rejections are therefore entirely meritless and should be reversed.

II. Rejection Under 35 U.S.C. 102(b)

The Examiner has withdrawn the rejection of claim 36 under 35 U.S.C. 102(b).

III. Rejection Under 35 U.S.C. § 112, First Paragraph

The only remaining rejection in the application is the rejection of claim 36 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

As set forth in their brief, it is Appellants' position that the text in dispute, "said biodegradable oxidized cellulose ester having an acid number of at least 133" is not new matter since the acid number of Appellant's claimed compounds merely identifies an inherent characteristic of the preferred compounds specifically described in Example 1 of the original disclosure. More specifically, the acid number of the preferred compounds is inseparable from the claimed compounds and their properties.

In response to Appellants' argument, the Examiner states that the conversion of carboxylic content to acid number in Example 1, "is insufficient documentation for support of claim limitation since Example 1 in the instant specification does not disclose the carboxylic content of the resulting compound thereof and does not set forth the acid number of the resulting compound." (Examiner's Brief, p. 4). What the Examiner ignores, however, is that the carboxylic content of the oxidized cellulose starting material is explicitly provided in Example 1, namely 13.7% (Specification p. 13). Using this starting material having a carboxylic content of 13.7% and the processing conditions specifically described in Example 1, the carboxylic content of the resulting product would inherently be 10.57, which directly converts to an acid number of 133.9.

The Examiner next argues that the written description requirement is not met on the basis the term "acid number", nor the carboxylic content upon which the claimed acid number is based is not literally disclosed in the specification. (Examiner's Brief, p. 4). Even if true, this finding has no bearing on the new matter analysis. Federal Circuit precedence provides that the relevant consideration under these circumstances is whether the claimed feature is an inherent property of the material disclosed.

For instance, the Federal Circuit held in Nathan that the applicant's addition of the orientation data of the claimed compound to the specification and claims after filing did not constitute new matter as the data was an inherent feature of the same. Application of Nathan, 328 F.2d 1005, 1006 (C.C.P.A. 1964). Similarly, in the Knight case, the Court allowed amendment to the chemical structure of the claimed compound since the amended structure was supported by the remaining disclosure, even though the amended chemical structure was not disclosed in the original specification or claims. Regents of the University of New Mexico v. Knight, 321 F.3d 1111, 1122 (Fed. Cir. 2003). Thus, the Examiner's requirement that the acid number and/or carboxylic content must have been previously referenced in the specification and/or claims is also not supported under the law.

Finally, the Examiner argues that the claimed feature of Appellant's oxidized cellulose ester of having an acid number of at least 133 is not supported in the specification on the basis that claim 36 does not also disclose an upper limit for the acid number. (Examiner's Brief, p. 4). This position simply makes no sense. Claim 36 as originally presented in Appellant's response dated October 24, 2003 did not include any data relating to the acid number of the claimed oxidized cellulose esters, and the Examiner did not issue an objection to the claim on the basis it was indefinite. It was only after Appellant amended claim 36 to include this inherent feature of the compounds that the Examiner made this objection. It is not understood how Appellant's amendment to claim 36 to more specifically identify the features of its compounds renders the claim less definite than was the claim prior to the

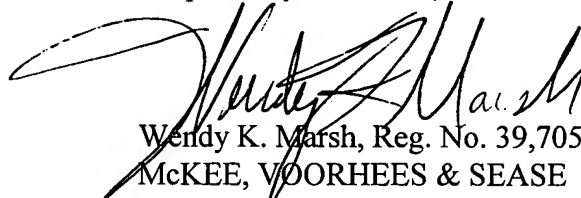
amendment.¹ Regardless, the fact remains that the minimum acid number is an inherent feature of Appellant's claimed oxidized cellulose esters, and therefore does not constitute new matter. Put another way, the lack of a maximum acid number for Appellant's claimed compounds does not render the minimum acid number a non-inherent feature of the same.

IV. Conclusion

Therefore, for the above-stated reasons, and for the reasons set forth in Appellants' appeal brief, Appellants respectfully request reversal of the decision of the Examiner, and allowance of the application.

It is not believed a fee is due with this brief. If a fee is due, please consider this a request to debit or credit Deposit Account No. 26-0084 accordingly.

Respectfully submitted,



Wendy K. Marsh, Reg. No. 39,705
McKEE, VOORHEES & SEASE
Attorneys of Record

801 Grand - Suite 3200
Des Moines, Iowa 50309-2721
515-288-3667 - wm -

¹ While the Examiner did not reject claim 36 as being indefinite for lack of an upper limit on the acid number, this appears to be the true nature of the Examiner's objection. It is respectfully submitted that claim 36 is not indefinite for lack of an upper limit for the acid number since a person skilled in the art would readily understand the scope of compound falling with the scope of the claim when the claim is read in light of the specification. Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 806 F.2d 1565, 1576 (Fed. Cir. 1986).